

Serial No. 10/692,513

PATENT
Docket No. 54317-022501REMARKS

Applicants have cancelled Claims 1-19 without prejudice or disclaimer, and have withdrawn Claims 20 and 21. In addition, Applicants have added Claims 22-48. Applicants submit that the claims are in condition for allowance.

Election/Restriction

The Examiner has required that the election of the following inventions be made:

- I. Claim 1-19, drawn to method of displaying content on a readable display in conjunction with a media presentation, classified in class 345, subclass 730.
- II. Claim 20-21, drawn to a portable device that automatically determines a user preference based on location, and automatically predicts the destination location, classified in class 725, subclass 35.

Responsive to the Examiner's requirement, Applicants provisionally elect Species I, with traverse. Claims 1-19 have been cancelled. Claims that are readable upon provisionally elected species or embodiments of Species I include new Claims 22-48.

The requirement for election by the Examiner is respectfully traversed because the Examiner has failed to show that there would exist a "serious burden" on the Examiner if all of the claims were examined together in one application.

Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected Claim 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 has been canceled.

Claim Rejections - 35 U.S.C. § 102 and 35 U.S.C. § 103

The Examiner has rejected Claims 1, 4-11, 14-19 under 35 U.S.C. § 102(e) as being anticipated by Wall et al. The Examiner has rejected Claims 2, 3, 12, and 13 under 35 U.S.C.

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103(a) as being unpatentable over Wall et al. While the claims in question have been canceled without prejudice, Applicants have introduced new claims which attempt to more accurately claim the invention.

Applicants submit that Wall does not teach all the elements and limitations of new Claims 22-48. In particular, claims 22-48 are directed to a method in which a media presentation is presented (at a first location) simultaneously with content data related to the media presentation on a portable device (at a second location). Wall is concerned with webcasting multimedia data to multiple users. Wall does not teach presenting content data at a first location or display, and multimedia data at a second location or display.

Wall on the other hand, discloses a system for creating and transmitting webcast programs involving a first media program (a slide presentation or program) and a second media program (a video presentation or program) which are transmitted to a recipient system where they are synchronized and displayed to a viewer. The recipient system is a viewer's computer ("devices connected to the internet for viewing webcast presentations") and as can be seen from Fig. 5a of Wall, the first and second media programs are displayed adjacent to one another on the same display screen.

This is also apparent from Figure 9 wherein the slides and the media presentation are downloaded together as part of the webcast.

The claims of the present invention involve presenting content data which is related to a media presentation (such as a movie) to viewers of the media presentation on a portable device which is located at a location substantially not the same as the location of the media presentation itself. For example, a movie being displayed on a display screen, and content data such as captioning being displayed on a portable device held by the viewer seated in the audience. This is substantially different from the teachings of Wall.

Wall fails to teach media presentation data and content data being presented separately (e.g. separate locations, separate displays, etc). Accordingly, applicants submit that independent

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Claims 22, 46, 47, 48 are not anticipated by Wall. Claims 23-45 depend from Claim 22. Accordingly, Claims 22-48 are not anticipated by Wall.

New Claims

Claims 22-48 are new claims that simply further define the invention. Additionally, all of the elements of Claims 22-48 are well supported in the original as-filed application and do not present new matter. As discussed above, Claims 22-48 are not taught in the prior art.

Conclusion

Applicants have complied with all requirements made in the above referenced communication. Accordingly, applicants respectfully request that a timely Notice of Allowance be issued in this case. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned agent.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number 50-2638. Please ensure that Attorney Docket Number 54317-022501 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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